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In re Application of:

HERMANSEN, CARSTEN et al

Serial No.: 10/523,924

Filed: Feb. 7, 2005

Docket: 742113-33

Title: DEVICE AND METHOD FOR
THROUGH-CUTTING OF AN
EXTRUDED ICE MASS

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8/14/09
DECISION ON PETITION
TO WITHDRAW DRAWING
OBJECTION

This is a decision on the petition filed on August 4, 2009 seeking reversal of the drawing objection under 37 CFR 1.83(a). The petition is being considered pursuant to 37 CFR 1.181. No fee is required.

The petition is **DISMISSED**.

In the petition, the petitioner requests a review of the examiner's objection to the drawings under 37 CFR 1.83(a). The examiner objected to the drawing on the grounds that the claimed subject matter of claims 1-14 was not illustrated. Petitioner believes that the objection to the drawings is in error and requests review and relief therefrom.

The record shows that:

1) In a Non-Final Rejection on June 1, 2009, Examiner rejected claims 1-14, *inter alia*, under 35 U.S.C. 112, first paragraph, because the disclosure does not provide sufficient support for the invention as claimed in claims 1-14. In particular, the drive structure of the cutting device. For example, the specific structure to simultaneously drive the knives and to provide the knives with different stroke lengths is not sufficiently disclosed and thus the description does not clearly allow persons of ordinary skill in the art to recognize that the present inventors invented what is claimed. Figure 5 does not clearly illustrate the structure to perform the claimed functions. The examiner also held that the claimed drive components including the rotor means, the coupling means and the rotating drive means are not sufficiently disclosed. It is not clear as to how they interact with one another as well as how they act together to drive the knives. Therefore, the specification does not convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention. The examiner further objected to the

drawings under 37 CFR § 1.83(a)¹ CFR 1.183a that the specific structure to simultaneously drive the knives and to provide the knives with different stroke lengths including the specific structure of the drive components including the rotor means, the coupling means and the rotating drive means must be shown or the feature(s) canceled from the claim(s).

2) In the petition, petitioner argues that the claimed features are derived from a text book relating to the filed of lever mechanisms, i.e., *MECHANISMS in Modern Engineering Design, Volume L" Lever Mechanisms* by Ivan I. Arobolevsky, D.Sc. (Eng.), Mir Publishers, Moscow, 1975. Therefore, this publication provides evidence of that which was well-known to those skilled in the art well prior to the present invention. Petitioner also argues that the claimed features are in fact shown in Figs. 3-5 to the extent required by 37 CFR 1.83(a).

Discussion and Analysis

A review of the record indicates that the drawing objection and claim rejection are directed to the same issues. In the rejection of claims 1-14 under 35 USC 112, first paragraph of the non-final Office action of June 1, 2009, the examiner stated that the applicant failed to comply with the written description requirement because the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (pages 3-4 of the Office action of June 1, 2009). The examiner also objected to the drawing that the claimed subject matters of claims are not illustrated by the original drawings. That is, the correctness of the examiner's drawing objection, resting on the lack of clarity of, the claimed specific structure "to simultaneously drive the knives and to provide the knives with different stroke lengths including the specific structure of the drive components including the rotor means, the coupling means and the rotating drive means" is dependent on the correctness of the examiner's 35 USC 112 first paragraph rejection of claims 1-14. It is the policy of the USPTO in appropriate circumstances to decline to rule on a petitionable issue, when, as here, that an issue is also determinative of a rejection, and as such, is appropriate for consideration on appeal to the BPAI. In this case, the issue in the objection and rejection, as here, additionally and necessarily requires the exercise of technical skill and legal judgment in order to evaluate the facts presented, the issue is properly decided on the merits, and is properly reviewed on appeal, not petition. Under the circumstances, it is believed that the issues presented under the claim rejections and drawing objection in the instant case require the same review by the BPAI. Thus, this issue is appealable and should not be decided by petition.


¹ § 1.83 Content of drawing. (a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

Conclusion

For the foregoing reasons, the relief requested by the petitioner will not be granted. Because there is both an objection to drawings under 37 CFR 1.83(a) and a rejection to claims under 35 USC 112, first paragraph, and both the correctness of the objection and the rejection depend on the same issue, the issue is an appealable one and will not be decided by petition.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3724 awaiting for the applicant's response to the non-final Office action of June 1, 2009. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-3468.

PETITION DISMISSED



Donald T. Hajec, Director
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